

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
(MBHB Case No. 02-090-B)

In re Application of: )  
 )  
Bakthavatchalam et al. )  
 )  
Serial No.: 09/910,442 ) Group Art Unit: 1624  
 )  
Filed: July 20, 2001 ) Examiner: Habte, Kahsay  
 )  
For: CAPSAICIN RECEPTOR LIGANDS )

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**  
**UNDER 37 C.F.R. §1.97(b)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450


Dear Sir:

In order to comply with discretionary regulations 37 CFR §§1.97 and 1.98, attached hereto is Form PTO-1449 and copies<sup>1</sup> of the documents listed thereon. These documents contain information that the Examiner may consider to be important in deciding whether to allow the present application to issue as a patent.

**United States Patents**

1. U.S. Patent No. 4,439,606, issued March 27, 1984
2. U.S. Patent No. 4,450,272, issued May 22, 1984
3. U.S. Patent No. 5,354,747 issued August 11, 1994

<sup>1</sup> To the extent that a document is listed and no copy of same is attached, then such document is not at the present time available to the undersigned or is available in the file of a parent application. If a listed document is not in the English language and an English translation is readily available, such translation is also attached; if translation is not attached it is not readily available to the undersigned. If a foreign language patent document is cited, and an English language equivalent is known to the undersigned, then such equivalent patent is also cited on the attached form along with the corresponding foreign language patent and a connecting arrow indicated therebetween; if no such English language equivalent is cited, then none is known to the undersigned.

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4. U.S. Patent No. 5,422,064 issued June 6, 1995
  5. U.S. Patent No. 5,461,047 issued October 24, 1995
  6. U.S. Patent No. 5,789,412 issued August 4, 1998
  7. U.S. Patent No. 6,028,195 issued February 22, 2000
  8. U.S. Patent No. 6,169,088 issued January 2, 2001
  9. U.S. Patent No. 6,329,395 issued December 11, 2001

**Foreign Patent Documents**

10. European Patent No. EP 0 100 200 A1<sup>1</sup> issued February 8, 1984
11. European Patent No. EP 0 100 200 B1<sup>1</sup> issued May 6, 1987
12. European Patent No. EP 0 790 240 A1<sup>1</sup> issued August 20, 1997
13. European Patent No. EP 1 122 242 A1<sup>1</sup> issued August 8, 2001
14. International Patent No. WO 00/17163<sup>1</sup> issued March 30, 2000
15. International Patent No. WO 00/27822<sup>1</sup> issued May 18, 2000
16. International Patent No. WO 00/52001<sup>1</sup> issued September 8, 2000
17. International Patent No. WO 00/63171<sup>1</sup> issued October 26, 2000
18. International Patent No. WO 02/05819<sup>1</sup> issued January 24, 2002
19. International Patent No. WO 94/29286<sup>1</sup> issued December 22, 1994
20. International Patent No. WO 96/01820<sup>1</sup> issued January 25, 1996
21. International Patent No. WO 96/02525<sup>1</sup> A1 issued February 1, 1996
22. International Patent No. WO 96/21648<sup>1</sup> issued July 18, 1996
23. International Patent No. WO 98/00402<sup>1</sup> issued January 8, 1998
24. International Patent No. WO 98/14431<sup>1</sup> issued April 9, 1998

25. International Patent No. WO 99/07672 issued February 18, 1999
26. International Patent No. WO 99/51582 issued October 14, 1999
27. International Patent No. WO 99/64394 issued December 16, 1999

**Other Documents – Including Author, Title, Date, Pertinent Pages, Etc.**

28. Kwak et al., Neuroscience (1998) 86: pp. 619-626.
29. Liu and Simon, Neuroscience Letters (1997) 228: pp. 29-32.
30. Ohkubo and M. Shibata, J. Dental Res. (1997) 76: pp. 848-851.
31. Pan and Sun, Tetrahedron Letters (1998) 39: pp. 9505-9508.
32. Santos and Calizto, Neuroscience Letters (1997) 235: pp. 73-76.
33. Urban, et al., Pain 89 (2000) pp. 65-74.
34. Wu et al., Gen Pharmacol (1996) 27: pp. 151-158.
35. Mokrosz et al (1992) J. Med. Chem. 35:2369-74 - note compound 31 on page 2370.
36. Prasad et al. (1968) J. Med. Chem. 11:1144-50 – note table 4.

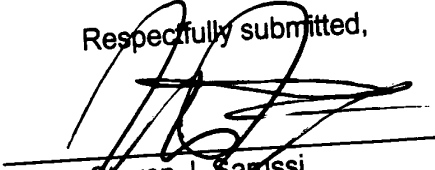
In accordance with MPEP Sections 609 and 707.05(b), it is requested that each document cited (including any cited in applicant's specification which is not repeated on the attached Form PTO-1449) be given thorough consideration and that it be cited of record in the prosecution history of the present application by initialing on Form PTO-1449. Such initialing is requested even if the Examiner does not consider a cited document to be sufficiently pertinent to use in a rejection, or otherwise does not consider it to be prior art for any reason, or even if the Examiner does not believe that the guidelines for citation have been fully complied with. This is requested so that each document becomes listed on the face of the patent issuing on the present application.

The present Disclosure Statement is being submitted in compliance with 37 CFR 1.56 insofar as an Examiner might consider any of the cited documents important in deciding whether to allow the application to issue as a patent, but the citation of each

document is not to be construed as an admission that such document is necessarily relevant or prior art. No representation is intended that the cited documents represent the results of a complete search, and it is anticipated that the Examiner, in the normal course of examination, will make an independent search and will determine the best prior art consistent with 37 CFR 1.104(a) and 1.106(b) and, in the course of each search, will review for relevance every document cited on the attached form even if not initialed.

Early and favorable consideration is earnestly solicited.

Respectfully submitted,

  
Steven J. Sardssi  
Reg. No. 52,784

Dated: July 2, 2003

Form PTO-1449 U.S. Department of Commerce Patent and Trademark Office  <b>SUPPLEMENTAL INFORMATION DISCLOSURE          STATEMENT BY APPLICANT</b>	Atty. Docket No.	Serial No.
	02-090-B	09/910,442
	Applicant: Bakthavatchalam, et al.	
	Filing Date: July 20, 2001	Group: 1624

## U.S. PATENT DOCUMENTS

Examiner Initial	No.	Document Number	Date	Name	Class	Subclass	Filing Date
	1.	4,439,606	3/27/84	Du			
	2.	4,450,272	5/22/84	Du			
	3.	5,354,747	8/11/94	Hansen			
	4.	5,422,064	6/6/95	Pieper			
	5.	5,461,047	10/24/95	Hansen			
	6.	5,789,412	8/4/98	Halazy			
	7.	6,028,195	2/22/00	Cho			
	8.	6,169,088	1/2/01	Matsuno			- -
	9.	6,329,395	12/11/01	Dugar			

## FOREIGN PATENT DOCUMENTS

Examiner Initial	No.	Document Number	Date	Country	Class	Subclass	Translation	
							Yes	No
	10.	EP 0 100 200 A1	2/8/84	EPO				
	11.	EP 0 100 200 B1	5/6/87	EPO				
	12.	EP 0 790 240 A1	8/20/97	EPO				
	13.	EP 1 122 242 A1	8/8/01	EPO				
	14.	WO 00/17163	3/30/00	PCT				
	15.	WO 00/27822	5/18/00	PCT				
	16.	WO 00/52001	9/8/00	PCT				
	17.	WO 00/63171	10/26/00	PCT				
	18.	WO 02/05819	1/24/02	PCT				
	19.	WO 94/29286	12/22/94	PCT				
	20.	WO 96/01820	1/25/96	PCT				
	21.	WO 96/02525 A1	2/1/96	PCT				
	22.	WO 96/21648	7/18/96	PCT				
	23.	WO 98/00402	1/8/98	PCT				

Examiner Initial	Date Considered
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EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with any communication.

Form PTO-1449 U.S. Department of Commerce Patent and Trademark Office  <b>SUPPLEMENTAL INFORMATION DISCLOSURE          STATEMENT BY APPLICANT</b>	Atty. Docket No.	Serial No.
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Examiner Initial	No.	Document Number	Date	Country	Class	Subclass	Translation	
							Yes	No
	24.	WO 98/14431	4/9/98	PCT				
	25.	WO 99/07672	2/18/99	PCT				
	26.	WO 99/51582	10/14/99	PCT				
	27.	WO 99/64394	12/16/99	PCT				

**OTHER DOCUMENTS - Including Author, Title, Date, Pertinent Pages, Etc.**

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	28.	Kwak et al., Neuroscience (1998) 86: pp. 619-626.
	29.	Liu and Simon, Neuroscience Letters (1997) 228: pp. 29-32.
	30.	Ohkubo and M. Shibata, J. Dental Res. (1997) 76: pp. 848-851.
	31.	Pan and Sun, Tetrahedron Letters (1998) 39: pp. 9505-9508.
	32.	Santos and Calizto, Neuroscience Letters (1997) 235: pp. 73-76.
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	36.	Prasad et al. (1968) J. Med. Chem. 11:1144-50 - note table 4.

<b>Examiner</b>	<b>Not Considered</b>
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